

**Remarks/Arguments**

Claims 11-19 are pending.

Claim 11 has been amended to revert, in part, to the version submitted by applicant on 2/09/09.

Claim 14 has been amended to delete 'comprises' and to add instead 'is' so that the claim now reads, *inter alia*, "wherein the dermatological composition is a tincture, lotion..."

The objection of claim 14 is believed to have been overcome by applicant's present amendment to claim 14.

The examiner's rejection of claim 16 (should be claim 15?) under 35 USC 112, second paragraph, is believed to have been overcome by applicant's deletion of 'flexible' from claim 15.

The rejection of claim 11, 14-15, and 17 -19, for the recitation of "treating neurodermatitis consisting essentially of a topical application ..." as being indefinite under 35 USC 112 is overcome by applicant's removal of this phrase.

The rejection of claims 11 and 14-19 under 35 USC 103(a) as being unpatentable over Buchholz et al. (US 2004/0053860 A1), is respectfully traversed. Here applicant submits that Buchholz et al. is an inappropriate reference being used against this application. In this respect, the following facts are pertinent:

- 1) September 02, 2002: filing of Buchholz's German patent application 102 40 923.4;
- 2) July 03, 2003: filing of applicant's German patent application 103 30 243.3;
- 3) September 02, 2003: filing of Buchholz's US patent application 10/652,043 claiming priority of German patent application 102 40 923.4;

- 4) March 04, 2004: publication of Buchholz's German patent application 102 40 923.4;
- 5) March 18, 2004: publication of Buchholz's US patent application 10/652,043 as US 2004/0053860 A1;
- 6) July 01, 2004: filing of applicant's PCT application PCT/EP 2004/007134 claiming the priority of German patent application 103 30 243.3; this PCT application designated the United States. The US national phase of this PCT application is the US application here at issue.
- 7) Section 2136.03 (b) of the MPEP states:

Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f)  
Cannot Be Used as the 35 U.S.C. 102(e) Reference Date

**35 U.S.C. 102(e)** is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under **35 U.S.C. 119(a)-(d) (f), and 365(a)** cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the **35 U.S.C. 102(e)** rejection by proving he or she is entitled to his or her own **35 U.S.C. 119** priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a **35 U.S.C. 102(e)** rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See **MPEP § 201.15** for information on procedures to be followed in considering applicant's right of priority. (emphasis added).

From the above, it would first appear that none of the Buchholz applications were published before the priority date of applicant's application, that is, July 03, 2003. Second, as stated by the MPEP, Buchholz's German application date September 02, 2002 cannot be used for prior art purposes. Accordingly, because

Buchholz's US application only became state of the art on September 02, 2003 (US filing date), it does not antedate applicant's filing date, and therefore Buchholz is not relevant prior art.

Notwithstanding the aforementioned, it should also be noted that Buchholz neither anticipate or make obvious the instant application because Buchholz describes a totally different class of compounds for the treatment of neurodermatitis. In this respect, Buchholz describes the use of flavonoids for the treatment of neurodermatitis. Ectoine is mentioned in connection with the protection of skin cells, in particular Langerhans cells. However, Buchholz did not recognize that ectoine or hydroxyectoine themselves are potent in the treatment of neurodermatitis.

No other issues remaining, applicant believes the claims are all in condition for allowance and respectfully solicits a Notice of Allowance.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-3881. If an extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-3881.

Dated: August 4, 2009

Respectfully submitted,

By   
Richard Y.M. Tun, Reg. No.: 56,594  
BERLINER & ASSOCIATES  
555 West Fifth Street, 31<sup>st</sup> Floor  
Los Angeles, California 90013  
(213) 533-4175  
(Fax) (213) 522-4174  
Attorneys for Applicant